

**Notice of Allowability**

Application No.

10/611,705

Examiner

Kurt Fernstrom

Applicant(s)

TITUS, PETER F.

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the Appeal Brief filed on May 2, 2005.
2. ☒ The allowed claim(s) is/are 1-20.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☒ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☒ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

**KURT FERNSTROM**  
**PRIMARY EXAMINER**

**DETAILED ACTION**

***Allowable Subject Matter***

Claims 1-20 are allowed.

The following is an examiner's statement of reasons for allowance: After a review of the claims in light of the Appeal Brief, it has been determined that the prior art, in particular the Goodman reference, does not fairly disclose or suggest the claimed invention. The arguments concerning the structure of the Goodman device remain largely unpersuasive, as they generally are directed to features that the Goodman device has which are not disclosed in the present invention, rather than the reverse. However, Goodman fails to disclose a list of words adjacent definitions, where the words are found in a predetermined book. The purpose of the device is to allow a reader to easily ascertain the definition of unfamiliar words found while reading, without having to consult a dictionary. This purpose is very different from those of Goodman, which are directed to either a listing of characters in a book, or answers to questions found in a book. In the first case, the Goodman device is useful as a memory aid, in that it allows a user to remember characters as they appear in the book. In the second case, an answer key is different from a listing of definitions, in that use of the device is required, rather than consulted as needed whenever an unfamiliar word is encountered. In both cases, the covering device of Goodman is critical to its application. As such, Goodman teaches away from the present invention, in that a listing of words with dictionary definitions does not lend itself to a device whose contents are selectively covered and uncovered. Applicant's invention is useful in that it operates as a reading

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aid which can be easily accessed to learn definitions of unfamiliar words which appear in the text. Because the claimed invention recites features which are not disclosed or suggested by the prior art, and because the purpose of these features differs substantially from those found in the prior art, the claims are allowed. Also, while the invention is essentially directed to printed matter, the printed matter is functionally related to the substrate in a new and nonobvious way, because the substrate is used as a bookmark for a preselected book. As a result, the claims cannot be rejected under the precepts of *In re Gulack*, which governs the patentability of printed matter. As a result.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (571) 272-4422. The examiner can normally be reached on M, T, Th 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF  
April 3, 2006

  
**KURT FERNSTROM**  
**PRIMARY EXAMINER**